



Attorney Docket No. 033679-040
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:

Kenneth G. Noggle

Application No.: 09/782,915

Filed: February 13, 2001

FOR: CUTTING TOOL ADJUSTMENT
DEVICE

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: Confirmation No.: 3193
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: Group Art Unit: 3722
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: Examiner: Dana Ross
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REPLY BRIEF

Mail Stop **APPEAL BRIEF-PATENTS**
Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

**I. Intended Use is Properly Arguable To
Overcome An Obviousness Rejection**

The Examiner dedicates over a page of the Examiner's Answer to arguing that intended use of the references cannot be discussed unless they are claimed in the present application. However, this assertion is flat wrong. In contrast, intended use can be argued to overcome an obviousness rejection. MPEP 2143.01V states that a proposed modification cannot render the prior art unsatisfactory for its **intended purpose**. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

This is precisely the argument made in Applicant's Appeal Brief. In discussing intended uses of the prior art, Applicant has presented evidence as to why modifying the

device of *Basteck* to include a wedging device that could be screwed directly into the holder would render the prior art unsatisfactory for its intended purpose. The Examiner simply has the case law incorrect.

II. The Examiner Has Failed To Refute Applicant's Argument Regarding Inoperability of the References

In Applicant's Appeal Brief, evidence was presented as to why one having ordinary skill in the art would not make the clamping device of *Basteck* directly attachable to the holder. See page 6, first paragraph to top of page 8. Instead, the Examiner states that there is nothing limiting the structure of *Basteck* that would prevent the intended use of screwing the wedging device of *Basteck* into the tool holder to such an extent that the wedge became lodged in the tool holder. Applicant respectfully disagrees and refers back to its arguments provided in the Appeal Brief on pages 6 through 8.

The Examiner further states that *Basteck* has expressly defined an area in the tool holder for the wedging device to extend beyond the intermediate components. See page 9, lines 7-8. However, this contradicts the purpose of *Basteck* which is for fine tuning or adjusting of the insert. This cannot be accomplished when the wedge is displaced axially, as conceded as a possibility by the Examiner.

To support the obviousness rejection, the Examiner relies merely on the allegation that *Basteck* and *Matthews* relate to problems of loosening of a wedging device, and are therefore, properly combinable. However, as noted in column 3, lines 45-51, *Basteck* uses a "viscous pincture" to prevent the wedging device from becoming loose, i.e., a viscous substance is applied to the screw to prevent the screw from being unintentionally released. This preserves the necessary spring force and operational relationship between the pin head 44 and the head screw 37. In contrast, attempting to attach the screw or wedging device directly into the holder would not preserve the relationship between these elements, but rather

could cause axial displacement of the countersunk screw 37, thereby affecting the fine adjustments of the tool. This would not be a desirable result. Accordingly, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness. There is no motivation to combine the two references in the manner suggested by the Examiner, and such modification would destroy the intended purpose of *Basteck*.

III. The Features of Claim 6 are Still Not Disclosed

On page 9, third paragraph, the Examiner alleges that *Basteck* discloses the features of Claim 6. On page 10 of the Examiner's Answer, the Examiner equates the cylindrical vertical face of the component 32 to the "end faces" as defined in Claim 6. However, if the vertical face is considered to be "the end faces," then the feature of the opposite end faces facing generally parallel to a direction of movement of the wedging device is not disclosed. In particular, the vertical face of the wedging device runs perpendicular to direction of movement of the wedging device, not parallel as defined in Claim 6. Accordingly, *Basteck* fails to disclose the features of Claim 6.

IV. Conclusion

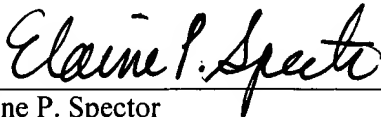
For at least the foregoing reasons, it is submitted that the final rejections of the Examiner should be reversed.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0573. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully Submitted,

Date: February 8, 2006
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